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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,995	02/05/2004	Georg Heinrich Matzen	033794/273258	5386
826	7590	10/04/2005	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			DUNWOODY, AARON M	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/772,995

Applicant(s)

MATZEN, GEORG HEINRICH

Examiner

Aaron M. Dunwoody

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 15-17 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 7-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/14/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on 7/14/2005. These drawings are not approved.

### ***Specification***

The abstract of the disclosure is objected to because the method of manufacturing the elastomeric joint is not part of the elected/claimed invention. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 15, 16 and 25-28 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 2879804, Hammond.

In regards to claim 1, Hammond discloses an elastomeric expansion joint comprising:

at least one first substrate (26);

at least one second substrate (24);

fabric layers (22) arranged between the first and the second substrates, defining a tubular section, wherein:

the tubular section comprises:

first and second end portions, a moveable central region (20), and

first and second intersection portions which are respectively defined between each of the end portions and the central region, and the intersection portions and the end portions define a reinforcement section; a first reinforcement wiring (30, 31) positioned in the reinforcement section; a second reinforcement wiring (34) positioned between the first and second substrates in the intersection portions; and at least one wiring support member (42) positioned between the first and the second substrates, wherein the wiring support member: is positioned in the reinforcement section, extends at least partially around a central axis of the tubular section, and supports at least the first reinforcement wiring along its length.

In regards to claim 2, Hammond discloses the wiring support member comprising a first wiring support member, the first wiring-support member comprising a base (tangent) and retention walls, the retention walls defining a retention region therebetween, and the first reinforcement wiring being positioned in the retention region.

In regards to claim 3, Hammond discloses the base of the first wiring support member being positioned parallel to the first and second substrates, with the retention region facing the second substrate.

In regards to claim 4, Hammond discloses the wiring support member supporting (capable) a plurality of overlapping layers of the first reinforcement wiring.

In regards to claim 15, Hammond discloses the end portions respectively end in retaining rings.

In regards to claim 16, Hammond discloses first and the second substrates being made of a polymeric material.

In regards to claim 25, Hammond discloses a wiring support member (36) comprising:

a substantially annular body having retention walls for at least partially facilitating lengthwise winding of the reinforcement wiring around the wiring support member.

In regards to claim 26, Hammond discloses the annular body further comprising a base from which the retention walls extend radially outward, wherein a retention region is at least partially defined between the retention walls, and the retention region is for receiving the reinforcement wiring.

In regards to claim 27, Hammond discloses a cross-section of the wiring support member being substantially U-shaped, with the cross-section being taken along a plane which is parallel to and intersects an axis which the wiring support member extends around.

In regards to claim 28, Hammond discloses the wire support member being positioned entirely within the reinforcement sections such that the wiring support member supports the first reinforcement wiring without preventing movement of the moveable central region.

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Claims 1-7, 15, 16 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 3429592, Merkwacz.

In regards to claim 1, Merkwacz discloses an elastomeric expansion joint comprising:

- at least one first substrate (30);

- at least one second substrate (36);

- fabric layers (22a,b) arranged between the first and the second substrates, defining a tubular section, wherein:

  - the tubular section comprises:

    - first and second end portions, a moveable central region (20), and

    - first and second intersection portions which are respectively defined

    - between each of the end portions and the central region, and the

    - intersection portions and the end portions define a reinforcement section;

    - a first reinforcement wiring (24, 26) positioned in the reinforcement section;

    - a second reinforcement wiring (28) positioned between the first and second substrates in the intersection portions; and

    - at least one wiring support member (34) positioned between the first and the second substrates, wherein the wiring support member:

      - is positioned in the reinforcement section,

      - extends at least partially around a central axis of the tubular section, and

      - supports at least the first reinforcement wiring along its length.

In regards to claim 2, Merkwacz discloses the wiring support member comprising a first wiring support member, the first wiring-support member comprising a base and retention walls, the retention walls defining a retention region therebetween, and the first reinforcement wiring being positioned in the retention region.

In regards to claim 3, Merkwacz discloses the base of the first wiring support member being positioned parallel to the first and second substrates, with the retention region facing the second substrate.

In regards to claim 4, Merkwacz discloses the wiring support member supporting a plurality of overlapping layers of the first reinforcement wiring.

In regards to claim 5, Merkwacz discloses the plurality of layers of the first reinforcement wiring being arranged in the retention region up to terminuses of the retention walls (but not contacting).

In regards to claim 6, Merkwacz discloses second wiring support members being respectively positioned in the first and second intersection portions.

In regards to claim 7, Merkwacz discloses each of the second wiring support members comprising retention walls defining a retention region therebetween, with the second reinforcement wiring positioned in the retention regions of the second wiring support members.

In regards to claim 15, Merkwacz discloses the end portions respectively end in retaining rings.

In regards to claim 16, Merkwacz discloses first and the second substrates being made of a polymeric material.

In regards to claim 25, Merkwacz discloses a wiring support member (34) comprising:

a substantially annular body having retention walls for at least partially facilitating lengthwise winding of the reinforcement wiring around the wiring support member.

In regards to claim 26, Merkwacz discloses the annular body further comprising a base from which the retention walls extend radially outward, wherein a retention region is at least partially defined between the retention walls, and the retention region is for receiving the reinforcement wiring.

In regards to claim 27, Merkwacz discloses a cross-section of the wiring support member being substantially U-shaped, with the cross-section being taken along a plane which is parallel to and intersects an axis which the wiring support member extends around.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond in view of US patent 3976312, Murphree.

In regards to claim 17, Hammond discloses the claimed invention except for a polytetrafluorethylene layer. Murphree teaches a polytetrafluorethylene layer (col. 1, lines 65-68). As Murphree relates to an expansion joint, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to provide a polytetrafluorethylene layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Allowable Subject Matter***

Claims 7-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 7/14/2005 have been fully considered but they are not persuasive. Applicant argues that Hammond does not teach the annular reinforcing element in a reinforcement section that is so located. The Examiner disagrees. In Figure 2, Hammond clearly illustrates the annular reinforcing element in a reinforcement section that is so located.

The Applicant argues:

Merkwacz similarly fails to disclose the wiring support member in a reinforcement section as recited in Claim 1. In this regard, the Office Action states indicates that the rubber ply 34 of Merkwacz corresponds to the wiring support member recited in Claim 1. However, the ply 34 of Merkwacz apparently extends throughout the whole expansion joint, including its central region. Therefore, to the extent that the ply 34 provides a reinforcing function in the reinforcement section, it also increases the rigidity in the central region, thereby preventing the central region from being moveable as claimed. This aspect of Merkwacz is also discussed in the present application at page 2, lines 23-28.

The Examiner disagrees. Claims 1 recites, "An elastomeric expansion joint comprising"; therefore, the claimed invention does preclude the wiring support member from extending throughout the entire expansion joint. Merkwacz meets the claim limitations.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aaron M Dunwoody  
Primary Examiner  
Art Unit 3679

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